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03 OCT 2008

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CHICAGO IL 60601

In re Application of:
NARESSI, Alexandre, et al. : DECISION ON PETITION UNDER
U.S. Application No.: 10/598,384 : 37 CFR 1.47(a)
PCT No.: PCT/EP2004/005398 :
International Filing Date: 25 February 2004 :
Priority Date: None :
Atty's Docket No.: 33836.00.0099 :
For: RFID PROTECTED MEDIA SYSTEM :
USING COMBINATION OF RFID :
ENABLED OBJECTS :
:

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(A) By Joint Inventor On Behalf Of Non-Signing Inventor" filed 23 September 2008. Deposit Account No. 22-0259 will be charged the required \$200 petition fee.

BACKGROUND

On 25 February 2004, applicants filed international application PCT/EP2004/005398. The international application did not claim an earlier priority date, and it designated the United States. On 01 September 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 25 August 2006.

On 25 August 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 27 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and \$210 in additional claims fees.

On 23 September 2008, applicants filed a response to the "Notification Of Missing Requirements" (with required four-month extension fee). The response included the authorization to charge Deposit Account No. 22-0259 for required fees (pursuant to which the Deposit Account will be charged the required surcharge and claims fees), a partially executed declaration, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks

acceptance of the application without the signature of co-inventor Patrice FAUVET, whom applicants assert has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants' petition is accompanied by a declaration executed by one of the two inventors of record containing an unsigned signature block for the non-signing inventor, Patrice FAUVET. This declaration can be accepted as having been executed by the signing inventor on his own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants have provided a firsthand statement, accompanied by supporting documents, demonstrating that a request for signature, accompanied by a copy of the complete application, was delivered to the non-signing inventor at his last known address and that the inventor has failed to provide the requested signature in response to such request. These materials provide an acceptable showing that the non-signing inventor has refused to execute the declaration. Item (4) is therefore satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of non-signing inventor Patrice FAUVET.

A notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the non-signing inventor of the application will be forwarded to the inventor's last-known address, as set forth in the petition.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including charging applicant for required claims fees. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 23 September 2008.



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In re Application of: NARESSI, Alexandre, et al.

U.S. Application No.: 10/598,384

PCT No.: PCT/EP2004/005398

International Filing Date: 25 February 2004

Priority Date: None

Atty's Docket No.: 33836.00.0099

For: RFID PROTECTED MEDIA SYSTEM USING COMBINATION OF RFID
ENABLED OBJECTS

Dear Mr. FAUVET:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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